

REMARKS

Presently, claims 4-6, 55-56, 59-60, 75, 78-79 and 90-91 are pending in the application. A Request for Continued Examination ("RCE") under 37 C.F.R. §1.114 is being filed herewith. Independent claims 4 and 90 have been amended to more clearly recite the present invention. Support for the amendments to claims 4 and 90 may be found, for example, at page 19, lines 4-10 and at page 29, line 10 – page 31, line 19 of the specification. Accordingly, no new matter has been added to the application by the foregoing amendments.

Descriptions of the prior art references referred to in this paper may be found in Applicants' previous Amendment, filed on March 2, 2005, which is incorporated herein by reference.

Claim Rejections – § 103(a)

The Examiner has rejected claims 4-6, 55-56, 59-60, 75, 78-79 and 90-91 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,698,020 to Zigmond *et al.* ("Zigmond") in view of U.S. Patent Publication No. 2003/0200128 A1 Doherty ("Doherty"). The Examiner contends that Zigmond teaches all features of the claimed invention with the exception of determining an order in which the advertisements are to be inserted and modifying that order based on a detected change. The Examiner further contends that Doherty teaches a schedule indicating an order in which advertisements are displayed and modifying that order based on user action. The Examiner concludes that it would have been obvious to modify Zigmond's system to include an ordered list, or queue, and modifying that order as taught by Doherty, resulting in Applicants' claimed invention. Applicants respectfully traverse this rejection.

Initially, Applicants respectfully, but strenuously, disagree with the Examiner's assertion that the combination of Zigmond and Doherty teaches the modification of an order, schedule or queue according to the displayed program content (see, for example,

the Examiner's arguments at pages 10-11 of the present Office Action). The Examiner argues that Zigmond teaches monitoring user interactions as well as selecting advertisements based at least in part on the program content that is being viewed. Because the Examiner reads Doherty to teach altering a schedule based on user interactions, the Examiner concludes from such a reading that Doherty's schedule is readily combinable with Zigmond's system, even though Zigmond does not even contemplate the use of a schedule, ordered list or queue.

However, Applicants disagree with the Examiner's reading of Doherty and, in particular the Examiner's interpretation of the schedule modification discussed therein. The Examiner argues that Doherty teaches altering of Doherty's schedule based upon user interactions, citing paragraph 30 of Doherty. However, this relied on portion of Doherty merely states that the "schedule is cleared and rescheduling is undertaken" in response to a user interrupt (see paragraph 30 of Doherty). Doherty goes on to describe on what basis the items of information may be prioritized: location, time, user profile and available time to compile the output. Accordingly, Doherty does not teach that the schedule is altered **based upon** the user's interactions. Rather, Doherty simply teaches that the schedule is altered **in response to** a user interaction – that is, in Doherty, a user interrupt **triggers** the alteration of the schedule. Moreover, even if Doherty could be construed to teach altering the schedule based on the user's interactions, Doherty still does not teach or suggest altering the schedule according to program content. That is, Doherty does not teach or suggest that the new or altered schedule is in any manner dependent on program content that is displayed as a result of a change in program content.

In Applicants' claimed invention, the triggering event is the detection of change in program content (however such change is initiated). As a result of the detection of different program content, Applicants' ordered list is reordered according to that different program content. Doherty does not teach or suggest such a concept. The fact that Zigmond may teach selecting advertisements based on currently viewed programming does not mean that the combination of Zigmond and Doherty teaches an ordered list or queue that is reordered according to the different program content – even if one or both of

these references detects a triggering event (e.g. a change in program content) and takes action as a result of that triggering event. On the contrary, the Examiner has still not pointed to any teaching that suggests modifying “the order in which the unscheduled advertisements are to be inserted according to program content displayed as a result of the detected change.”

Furthermore, the Examiner appears to be inconsistent in applying the teachings of the references to Applicants’ claims. That is, at page 3 of the Office Action, the Examiner admits that Zigmond “fails to specifically disclose determining an order in which the advertisements are to be inserted and modifying the order based on a detected change.” As noted, the Examiner relies on Doherty to teach these features. However, in responding to Applicants’ arguments at page 11 of the Office Action, the Examiner does not rely on Doherty to teach modifying the schedule based on the program content, but finds support in Doherty only for “altering the schedule based upon user interactions.” For the reasons discussed above, Applicants respectfully submit that this is incorrect. The Examiner goes on to suggest that Zigmond’s teaching of “selecting advertisements based upon the current viewed program...and monitoring user interactions which includes program and channel changes” is sufficient to satisfy deficiencies in Doherty’s teachings. Applicants respectfully submit that the Examiner has thus stated contradictory arguments with respect to the teachings of the prior art. That is, the Examiner cannot rely on Doherty for the teaching of modifying a schedule, and then rely on Zigmond for the teaching of how that schedule is modified (e.g., according to program content), when Zigmond (as admitted by the Examiner) does not even teach or suggest a schedule or the modification thereof in the first place. Accordingly, Applicants respectfully submit that the Examiner’s combination of Zigmond and Doherty is flawed, and that the Examiner’s contention that the combination of Zigmond and Doherty teaches the reordering of advertisements according to the changed program content is incorrect.

Independent claim 4, as amended, recites:

A subscriber system for inserting unscheduled advertisements into at least one channel of media signals, the system comprising:

an ad insertion device configured to determine an order in which the unscheduled advertisements are to be inserted into the at least one channel and insert the unscheduled advertisements into the at least one channel according to the order; and

a watchdog module coupled to the ad insertion device, the watchdog module configured to detect a change in current program content being displayed on the at least one channel and output results of the detection to the ad insertion device, such that the ad insertion device modifies the order in which the unscheduled advertisements are to be inserted according to program content displayed as a result of the detected change.

When making a rejection under 35 U.S.C. § 103, the Examiner has the burden of establishing a *prima facie* case of obviousness. The Examiner can satisfy this burden only by showing an objective teaching in the prior art, or that knowledge generally available to one of ordinary skill in the art, would lead that individual to combine the relevant teachings of the references in the manner suggested by the Examiner. *See In re Fine*, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1998). The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not the applicant's disclosure. *See In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). The mere fact that the prior art could be modified in the manner proposed by the Examiner, does not make the modification obvious unless the prior art suggests the desirability of the modification. *See Ex Parte Dussaud*, 7 U.S.P.Q.2d 1818, 1820 (Bd.Pat.App & Interf. 1988).

Applicants respectfully submit that there is no motivation found in either Zigmond or Doherty to combine these references as suggested by the Examiner. As admitted by the Examiner at page 3 of the Office Action, Zigmond does not teach or suggest the use or determination of an ordered list, schedule or queue for displaying advertisements, nor does Zigmond teach or suggest the modification of such an order or queue. Zigmond's system also does not need nor contemplate the need for an ordered list or advertisements. The Examiner has not pointed to, nor is there, any objective teaching

in Zigmond to suggest the addition of an ordered list (and the modification thereof) to Zigmond's system. The Examiner has merely suggested that one of ordinary skill in the art would combine Doherty with Zigmond to ensure "that advertisements are properly prepared for display when needed thereby promoting efficient advertisement delivery" (see page 4 of the Office Action). However, such a teaching or motivation is not found in either of the references, nor would one skilled in the art necessarily think to add a schedule and a modification thereof (according to program content) as taught by Doherty to Zigmond's system. This is because Zigmond itself teaches an advertisement insertion system that functions efficiently as disclosed. Moreover, Zigmond's system already has the ability to select the desired advertisement(s) "on demand", thereby obviating the need for a modifiable schedule or queue as suggested by the Examiner. Since the prior art has not suggested the desirability of such a modification (within the prior art itself), the Examiner has not satisfied this requirement of establishing a *prima facie* case of obviousness. Accordingly, Applicants respectfully submit that the proposed combination of Zigmond and Doherty is improper.

Moreover, the prior art references, when combined, must teach or suggest all of the claim limitations. *See* MPEP 2143. As discussed, even if Doherty's system teaches determining an "order" or "queue" for the insertion of advertisements, Doherty does not teach or suggest modifying that order "according to program content displayed as a result of the detected change," as recited in independent claim 4. That is, the "current conditions" which Doherty's system uses to prioritize the advertisements and generate a schedule do not include the currently displayed program content (be it program content displayed before or after a detected change in the content). Nor does Doherty teach or suggest that any modification to the schedule is made based on or according to the actual user interaction. Thus, Doherty's schedule is not reordered or modified according to program content displayed as a result of the detected change, as recited in claim 4. Since Doherty does not teach or suggest the features recited in independent claim 4, as argued by the Examiner, the combination of Doherty with Zigmond, even if proper, still lacks such a teaching. Furthermore, even if the references are combined (as suggested by the Examiner) such that Zigmond's teaching of "selecting advertisements based upon the

current viewed program...and monitoring user interactions which includes program and channel changes” is sufficient to satisfy the deficiencies of Doherty’s schedule, for the reasons discussed above, such a combination still lacks a teaching of modifying “the order in which the unscheduled advertisements are to be inserted according to program content displayed as a result of the detected change.”

Accordingly, Applicants respectfully submit that the Examiner has not met the burden of *prima facie* obviousness, since the Examiner has not pointed to an objective teaching or combination of references which disclose Applicant’s claimed invention and the motivation to combine them. Furthermore, even assuming the references are properly combinable, not all of the features of Applicants’ claimed invention would be taught. Thus, independent claim 4 is believed to be allowable over the combination of Zigmond and Doherty.

New independent claim 90 recites the steps of “generating a queue having unscheduled targeted advertisements...the queue indicating an order in which the advertisements are to be presented; detecting a change in the current program content...; and reordering the queue according to program content displayed as a result of the change detected in step (d).” For the same reasons discussed above with respect to independent claim 4, the combination of Zigmond and Doherty is improper and the combination of such references, even if proper, still does not teach or suggest all of the elements of independent claim 90. Accordingly, independent claim 90 is believed to be allowable over Zigmond and Doherty, taken either alone or in combination.

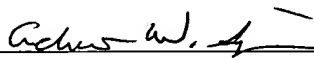
Dependent claims 5-6, 55-56, 59-60, 75, 78-79 and 91 are allowable at least by their dependency on independent claims 4 and 90, respectively. Reconsideration and withdrawal of the Examiner's §103(a) rejection are respectfully requested.

Conclusion

In view of the foregoing amendments and remarks, Applicants respectfully submit that the Examiner's rejection has been overcome, and that the application, including claims 4-6, 55-56, 59-60, 75, 78-79 and 90-91, is in condition for allowance. Reconsideration and withdrawal of the Examiner's rejection and an early Notice of Allowance are respectfully requested.

Respectfully submitted,

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